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FITCH EVEN TABIN & FLANNERY  
120 SOUTH LASALLE STREET  
SUITE 1600  
CHICAGO, IL 60603-3406

EXAMINER

ANDERSON, FOLASHADE

ART UNIT

PAPER NUMBER

3623

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/820,470

**Applicant(s)**

ENDLER ET AL.

**Examiner**

FOLASHADE ANDERSON

**Art Unit**

3623

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 18-22 and 24-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17, 23 and 29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This final office action is in response to Applicant's 09/23/2008 filing. Currently, claims 1-17, 23 and 29 are pending. Claims 18-22 and 24-28 are withdrawn. Claims 1, 17, 23, and 29 are amended.

### ***Response to Arguments***

2. Applicant's arguments have been fully considered but they are not persuasive. Applicant argues that 1-16 and 23 meet the requirements for patentable subject matter under 35 USC 101, specifically "displaying the meeting location on a screen is a sufficient tie" and "the claim language transforms the underlying subject matter to a different state or thing . . . the meeting place is selected, the location's attributes are changed from a generic location to a meeting place." However based on Supreme Court precedent, and recent Federal Circuit decisions that a method (process) must be (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876). Applicant's reasoning of the claimed limitation nor the claimed language itself is sufficient to satisfy the required tie or transformation; therefore, the rejection is maintained.

Meaningful limits have been imposed by the Office to limit the scope of a method claims to significant solution activities in order to satisfy in the machine or

transformation test. As amended "displaying the meeting location on a screen" is simply a step of outputting as such insignificant extra solution activity. Thus the amendment to include the output step does not transform the previously unpatentable limitation into a patentable process.

Regarding the transformation requirement under 35 U.S.C. 101, Examiner notes that the Federal Circuit has held unpatentable a process of graphically displaying variances of data from average values that neither specified any particular type or nature of data nor how or from where the data was obtained or what the data represented. In re Abele, 684 F.2d 902, 909; see also In re Meyer, 688 F.2d 789, 792-93 (CCPA 1982) (process claim involving undefined "complex system" and indeterminate "factors" drawn from unspecified "testing" not patent-eligible). In contrast, the court has held one of Abele's dependent claims to be drawn to patent-eligible subject matter where it specified that "said data is X-ray attenuation data produced in a two dimensional field by a computed tomography scanner"; wherein this data clearly represented physical and tangible objects, namely the structure of bones, organs, and other body tissues. Abele, 684 F.2d at 908-09. Thus, the transformation of that raw data into a particular visual depiction of a physical object on a display was sufficient to render that more narrowly-claimed process patent-eligible.

Applicant's limitation, "selecting a meeting location from the plurality of possible meeting locations" is more akin to the unpatentable claim in Abele in that it displays a change or variance in data, than the patentable claim in Abele, in which the raw data was used to create a visual representation of a physical object. Therefore, claims 1 and

23 are considered non transformational and do not meet this prong of the machine-transformation test under 35 U.S.C. 101.

3. It is noted that Applicants assertions "that the above references, alone or in combination, fail to teach, suggest or make obvious Applicants' new claimed features" are directed to the newly amended claim language which has been fully addressed in the updated rejection.

#### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-16 and 23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

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With respect to independent claim 1, the claim language recites the steps of detecting, identifying, selecting, etc.; however the claim language does not include the required tie or transformation.

Claims 2-16 and 23 are rejected based upon the same rationale, wherein the claim language does not include the required tie or transformation.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 9, 10, 15-17, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson et al (US Publication 2004/0203901) in view of Jones et al (US Patent 7,181,410 B1).

Claim 1 Wilson teaches a **method comprising:**

- **detecting a plurality of participants** (0039 system obtain a request from a first mobile device for a meeting with a person associated with a second mobile device);
- **detecting a location of each of the plurality of participants** (0039, the system automatically determines locations of the first and second mobile device);

- **identifying a plurality of possible meeting locations based on a parameter** (0093, the portal receives from the location engine a list of all POI's fulfilling the user's desired criteria, where POI is a location).
- **selecting a meeting location from the plurality of possible meeting locations based on the location of each of the plurality of participants** (0039, automatically provides information to at least the first or second mobile device regarding a meeting location based at least in part on the determined location of the first or second mobile device, also see 0098); and
- **displaying the meeting location on a screen** (0093, provides to the user's wireless device a POI display, #214 of fig 2A, and figure 9)

Wilson further teaches that the use can narrow the locations selection by for example categories "restaurants, bars, parks, cafes, etc" however it is not expressly taught that the location selection takes amenity preferences in to consideration.

Jones teaches in an analogous art for the purpose of goal oriented travel:

- **detecting a plurality of amenities preferences from the plurality of participants** (col. 7, lines 35-37);
- **selecting a meeting location from the plurality of possible the plurality amenities preferences** (col. 7, lines 42-44)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the invention of Wilson the **amenities preferences** as taught by Jones since the claimed invention is merely a combination of old elements,

and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 9 Wilson teaches **location of one of participants is a current location detected through a device detection module** (0049, the GMLC includes a phone locator subsystem that work with the GMLC such as the e-Mobility Location Center provided by Nortel).

Claim 10 Wilson teaches **the location of one of participants is a projected location based on a previous location of the participant at a time and date which corresponds to a time and day of a possible meeting** (0039).

Claim 15 Wilson teaches **parameter a geographic area** (0092, user selects a neighborhood/city/sites and provides this information to the portal and 0093, the user's desired criteria).

Claim 16 Wilson teaches **the meeting location is geographically located between the location of each of the participants** (0098, coordinate a meeting equidistant between these friends and the user. The system via the location engine computes a midpoint between the user and friends and performs the functions above to permit the user to identify a desired POI at this midpoint or "geographic center").

Claim 17 and 29 which are directed toward the system and medium respectively for implementing the method of claim 1 is substantially similar to claim 1 and is therefore rejected for the same reasoning given above with regards to claim 1.



7. Claims 2-5, 7, 8 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson et al (US Publication 2004/0203901) and Jones et al (US Patent 7,181,410 B1) as applied to claim 1 and in further view of Perrella et al (US Patent 7,139,722).

Claim 2 Wilson is silent on **determining a mode of transportation for each of the plurality of participants.**

Perrella teaches **determining a mode of transportation for each of the plurality of participants** (col. 5, lines 21-26) in an analogous art for the purpose of calculating estimated arrive times to a meeting.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Perrella in the invention of Wilson to allow notification of the user's timeliness to other meeting participants (Perrella col. 1, lines 46-49).

Claim 3-5 which are direct to a specific mode of transportation i.e. **car, bus, foot** Wilson is silent on these features. However official notice is taken that **car, bus, foot** were old and well known know modes of transportation at the time the invention was made as evidenced by Perrella (col. 5 lines 22-23).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the any old and well know mode of transportation in the invention of Wilson to allow notification of the user's timeliness to other meeting participants (Perrella col. 1, lines 46-49).

Claim 7 Wilson and Perrella are silent on **determining the mode of transportation for each of the plurality of participants is based on a time and day of a possible meeting.**

Jones teaches **determining the mode of transportation for each of the plurality of participants is based on a time and day of a possible meeting** (abstract) for the purpose of goal oriented travel.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Jones in the invention of Wilson to ensure the user's arrive at the meeting on time (col. 1, lines 42-44).

Claim 8 Wilson and Perrella are silent on **determining the mode of transportation for each of the plurality of participants is based on a speed of movement of each of the plurality of participants.**

Jones teaches **determining the mode of transportation for each of the plurality of participants is based on a speed of movement of each of the plurality of participants** (abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Jones in the invention of Wilson to ensure the user's arrive at the meeting on time (col. 1, lines 42-44).

Claim 23 is substantially similar in scope to claims 1, 2, 6, and 8 and is therefore rejected for the same reasoning given above with regards to these claims. Additional claim 23 recites the additional limitation of **confirming the mode of transportation based on the speed of movement.** This limitation is taught by Jones (col. 4, lines 3-5).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Jones in the invention of Wilson to ensure the users arrive at the meeting on time (col. 1, lines 42-44).

8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson et al (US Publication 2004/0203901) Jones et al (US Patent 7,181,410 B1) and Perrella et al (US Patent 7,139,722) as applied to claim 2 and in further view of Hall (US Patent 6,937,853 B2).

Claim 6 Wilson teaches **selecting the meeting location** (0098); however Wilson is silent that this selection **is based on the mode of transportation for each of the plurality of participants.**

Perrella is silent on **selecting the meeting location is based on the mode of transportation for each of the plurality of participants.** However Perrella takes into the mode of transportation when predicting a user's meeting arrival time (col. 5, lines 20-24)

Hall teaches **selecting the meeting location is based on the mode of transportation for each of the plurality of participants** (col. 1, lines 55-65, where a fleet of vehicles is equivalent to the mode of transportation) in an analogous art for dynamically updating data.

It would have been obvious to one of ordinary in the art at the time the invention was made to include the teachings of Hall in the invention of Wilson to allow for

accurate accounting for a common acceptable meeting time among meeting participations

9. Claims 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson et al (US Publication 2004/0203901) and Jones et al (US Patent 7,181,410 B1) as applied to claim 1 and in further view of Official Notice.

Claims 11 and 12 which are directed toward a specific type of meeting location, parameter i.e. **food service, beverage service**. Official notice is taken that **food service, beverage service** were old and well known location types at the time the invention was made as evidenced by Wilson (0092, categories may include for example, restaurants, bars).

Further the Examiner holds that specifying a specific type of parameter is nonfunctional material and is not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP, 2106

Claims 13 and 14 are similar in scope to claims 11 and 12 in that they are directed toward nonfunctional material as such are rejected for the same reasoning given in regards to claims 11 and 12.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bingham et al (US Patent 6,324,517 B1) teaches selecting a meeting location based on the location and amenities.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **FOLASHADE ANDERSON** whose telephone number is (571)270-3331. The examiner can normally be reached on Monday through Thursday 8:00 am to 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Folashade Anderson/  
Examiner, Art Unit 3623

/Andre Boyce/  
Primary Examiner, Art Unit 3623